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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN MICHAEL REUNING
and NICOLE L. BAKOS

Appeal 2006-0580
Application 09/911,024
Technology Center 3600

Decided:¹ March 6, 2009

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
JAMES T. MOORE, *Vice Chief Administrative Patent Judge*,
KENNETH W. HAIRSTON, ALLEN R. MACDONALD,
and, ROBERT E. NAPPI, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Any applicable time period for the Appellant(s) to take further action in this case, such as the time periods proscribed by 37 C.F.R. §§ 1.304 and 41.50(b), begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

BACKGROUND - PROCEDURAL

The Appellants appealed under 35 U.S.C. § 134 from a final rejection of claims 1 to 66. In a decision dated November 30, 2006, the Board reversed the decision of the Examiner rejecting claims 1 and 2 under 35 U.S.C. § 103(a), and affirmed the decision of the Examiner rejecting claims 3 to 66 under 35 U.S.C. § 103(a) because “the appellants have not presented any patentability arguments for these claims.”

Our reviewing court in *In re Reuning*, 276 Fed. Appx. 983 (Fed. Cir. April 25, 2008) (unpublished) vacated-in-part the Board’s decision with respect to claims 3 to 66, and remanded for further proceedings. Specifically, we are mandated to conduct “additional investigation and explanation” *Id.* at 987.

After additional investigation and reconsideration of the record on appeal, we hereby vacate the remainder of the original Board decision which reversed the rejection of claims 1 and 2.

We shall sustain the Examiner’s obviousness rejections of claims 1 to 66.

BACKGROUND - FACTUAL

Summary of Appellants’ Invention

The Appellants have invented a method and a system for harvesting professional profile contact information data via a search of the internet (Spec. 1 to 3).

Representative Claim

Claim 1 was selected by the Appellants as a representative claim for the rejections, and it reads as follows:

1. A method for harvesting professional profiles, the method comprising:

Searching the Internet,

Identifying web pages and Internet postings containing professional profile data,

Collecting said professional profile data,

Identifying in said professional profile text strings constituting contact information data, and

Storing said Professional Profile and said contact information data into a data structure. (Br. at 21).

Prior Art

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Peach	US 5,321,604	Jun. 14, 1994
Boguraev	US 5,799,268	Aug. 25, 1998
Hartman	US 2002/0111958 A1	Aug. 15, 2002 (effective filing date Feb. 8, 1996)

Watter S. Mossberg (Mossberg), *Personal technology: Threats to privacy on-line become more worrisome*, Wall Street Journal, New York, Oct. 24, 1996.

Examiner's Rejections

The Examiner rejected claims 1 to 25, 33 to 58, and 66 under 35 U.S.C. § 103(a) based upon the teachings of Hartman, Mossberg, and Boguraev.

The Examiner rejected claims 26 to 32 and 59 to 65 under 35 U.S.C. § 103(a) based upon the teachings of Hartman, Mossberg, and Peach.

ISSUES

Have the Appellants shown error in the Examiner's finding that the applied references would have suggested to one of ordinary skill in the art the claimed harvesting of professional profiles via the internet, and the conclusion that the subject matter of claims 1 to 11, 13-25, 33 to 44, 46 to 58, and 66 would have been obvious?

Have the Appellants shown error in the Examiner's finding that the nonfunctional descriptive material of claims 12 and 45 does not distinguish these claims from the prior art, and the conclusion that the subject matter of claims 12 and 45 would have been obvious?

Have the Appellants shown error in the Examiner's articulated reasoning and conclusion that collecting computer stored data and combining that data into a deliverable medium of claims 26 to 32 and 59 to 65 would have been obvious to the skilled artisan?

FINDINGS OF FACT

1. The Appellants have acknowledged that claim 1 has five steps, “each one of which is known in the art” (Br. 3).

2. Mossberg discloses a method called “mining” which involves “scooping up” information from discussion sites on the internet. (Mossberg, ¶ 9).

3. Mossberg describes those discussion sites as public discussion groups in which individuals have participated (Id.).

4. Mossberg describes that the information can include email addresses. (Id.).

5. Mossberg describes publishing the information in a directory site (Id.).

6. The Appellants specification notes that:

The invention is generally applied to advertise to end users of business product and potential employee recruits. Thus, the descriptions herein refer mostly to contact information based on professional profile data. (Specification, page 11, ll. 29-32).

7. Professional profile data includes contact information. (FF6).

8. An email address is a form of contact information.

9. Mossberg therefore describes the steps of searching the internet, identifying web pages and internet postings containing professional profile data, and collecting said professional profile data.

10. Boguraev also describes a method of analyzing online technical information using computer-mediated linguistic analysis to extract useful knowledge. (Col. 4, ll. 52-57).

11. Boguraev's analysis includes "mining" online knowledge (col. 57, ll. 10-15) by syntactic recognition by a pattern recognition engine (col. 58, ll. 24-39).

12. Boguraev therefore describes identifying text strings constituting useful data from online sources (FF 11).

13. Hartman (Fig. 1) describes an internet based resume storage and retrieval system 10 that comprises a World Wide Web server 12 that includes a memory 14 and a database 16 (§ 0040). The communication hardware 24 in Figure 2 of Hartman connects the server 12 to the internet (§ 0040) using TCP/IP Internet protocol (§ 0043).

14. Hartman states that "[t]he form 30 is useful in that it provides searchable information" (§ 0054), and "[f]or World Wide Web applications, the form 30 is an HTML form" (§ 0047).

15. Hartman describes a client 138 in communication with the server 12 via the internet (§§ 0057 to 0059) conducting a keyword search (§ 0060) for specific profile contact information data (§§ 0061 and 0064) in resumes.

16. Hartman stores the search requests and results at server 12 (§§ 0068 and 0132).

17. Hartman describes the storing of contact information in the server (§ 48).

18. Hartman therefore describes storing professional profile information and contact information data into a data structure on a web server. (FF 13-17).

PRINCIPLES OF LAW

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”
KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007).

ANALYSIS

I. The Rejection of Claims 1-11, 13-25, 33-44, 46-58 and 66 over the combination of Hartman, Mossberg, and Boguraev.²

The Examiner has found that Hartman describes a method of collecting professional profile data, identifying contact information data, and storing professional profile information and contact information in a data structure. (Ans. at 5, Final Rejection at 2).

The Examiner has additionally found that Mossberg discloses a method for harvesting professional profiles by searching the internet, and identifying web pages and internet postings containing profile data. (Ans. at 6, Final Rejection at 3).

Moreover, the Examiner has found that Boguraev describes identifying data in document text strings. (Ans. at 6, Final Rejection at 3).

The Examiner then concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to search the internet, identify web pages containing profile data, and identify text strings in the data as described in the combination of Boguraev, Mossberg, and Hartman to increase effectiveness and customer reach by obtaining profile data directly from the internet. (Ans. at 7, Final Rejection at 3).

² Office Action, December 30, 2003, p. 2. The examiner’s answer of July 21, 2004 combines this rejection with the rejection of claims 12 and 45 at p. 2. We address them separately.

With this background in place, we look at the arguments raised by the Appellants.

a) Antedating of Mossberg

The Appellants urge that all rejections which include Mossberg should be reversed because the Appellant “possessed at least two of the five claim limitations recited in pending claim 1” (Br. at 7) and possession is established by the Rule 131 (37 CFR §1.131 (2008) declaration of the inventor of July 14, 2000.

Rule 131 reads as follows, in pertinent part (bracketed material added):

§ 1.131 Affidavit or declaration of prior invention

(a) When any claim of an application . . . is rejected . . . the inventor [Reuning in this case] of the subject matter of the rejected claim . . . may submit an appropriate . . . declaration to overcome the patent or publication. The oath or declaration must include facts showing a completion of the invention in this country . . . before the date of the printed publication . . .

(b) The showing of facts shall be such, in character and weight, as to establish [1] reduction to practice prior to the effective date of the reference, or [2] conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent [actual] reduction to practice or to the filing of the application [i.e., a constructive reduction to practice]. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the . . . declaration or their absence must be satisfactorily explained.

A declaration submitted pursuant to Rule 131 is evaluated on its merits by considering the evidence relied upon in light of the arguments made explaining why the evidence is sufficient. The Board has broad discretion as to the weight to be given the evidence. *In re American*

Academy of Science Tech Center, 367 F.3d 1359, 1368 (Fed. Cir. 2004); *In re Inland Steel, Co.*, 265 F.3d 1354, 1366 (Fed. Cir. 2001). The Board also assesses the credibility of any witness. *In re Curtis*, 354 F.3d 1347, 1354 (Fed. Cir. 2004).

Procedurally, the Appellants failed to file the declaration in the present application file 09/911,024. The Examiner did not consider it because it was not of record in the pending application. The Appellants have now supplied it as an attachment to the Brief on Appeal. For that reason alone, this argument is without merit.

Moreover, we note that the declaration is on its face legally insufficient. It fails to address each claim element and explain why each action referenced in the declaration was either a conception or a reduction to practice. For example, paragraph 3 states, without elaboration, regarding conception:

3. I conceived of a system for searching for potential employment candidates. I conceived of a system including each of the elements of my currently-pending claims. I did this not later than September 10, 1996.

First, that statement relates to a completely different set of claims in a different application. Second, even were we to accept the declaration, it does not state what was done and how it relates to the claim elements. The declaration does not state with any specificity what was conceived or what was reduced to practice and how. Consequently, the facts recited in the declaration and accompanying argument are insufficient to establish conception or reduction to practice of any of the individual elements of the instant claims before the date of the reference.

We note the Appellants appear to argue that possession of two of the five elements of the claim is enough to establish conception or reduction to practice, citing *In re Spiller*, 500 F.2d 1170 (C.C.P.A. 1974) and *In re Stryker*, 435 F.2d 1340(C.C.P.A 1974). This argument, regardless of whether it has any potential merit, is inapplicable to the instant appeal. The Appellants have not shown an antedating conception or reduction to practice involving any of the elements of the instant claims with sufficient credible evidence.

This argument therefore is unpersuasive of error on the part of the Examiner on its merits.

b) The Arguments Concerning Hartman, Mossberg, and Boguraev

The Appellants discuss each reference individually and raise numerous grounds of appeal, including a lack of motivation to combine in the references of record (Br. 14, 17, and 18), non-analogous prior art references (Br. 16), and a teaching away in individual references (Br. 13).

The claimed steps were well-known in the art

It is not in dispute that the claimed method steps were well known in the art. Arguments not made in the Brief are waived. *See Hyatt v. Dudas*, 551 F.3d 1307, 1313-14 (Fed. Cir. 2008).

Further, Appellants' statement in the Brief that "claim 1 requires five elements, each one of which is known in the art" (Br. 3) is binding on the Appellants as an admission that the steps are prior art to them for purposes of determining the obviousness of the claimed method, and is "an admission that that matter is prior art for all purposes" *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d at 1570; *In re Nomiya*, 509 F.2d at 571 n.5.

Moreover, the art of record amply supports the proposition that each step was individually known to be performed in related art.

Mossberg describes data mining of email addresses (a form of contact information, which falls within the claimed professional profile) from the internet and publishing that information in a database. Mossberg therefore describes the steps of searching the internet, identifying web pages and internet postings containing professional profile data, and collecting said professional profile data.

Boguraev describes a method of analyzing online technical information using computer-mediated linguistic analysis to extract useful knowledge. Boguraev uses the term “mining” in reference to this online knowledge by syntactic recognition by a pattern recognition engine.

Hartman describes an internet-based resume storage and retrieval system that includes a web based server having a database structure.

One of ordinary skill in the art at the time the invention was made would therefore recognize that these five steps set forth in claim 1 were well known in the art at the time the invention was made.

The results of this combination were predictable

The record is completely silent as to any unpredictable results that flowed from Appellants’ combination of the five well-known steps set forth in claim 1 (Br. 3). Based upon the teachings of Hartman, as buttressed by Appellants’ admission and the cumulative teachings of Mossberg and Boguraev, we find that the claim 1 combination made by Appellants yielded predictable results as opposed to unpredictable results. Attorney argument aside, there is no persuasive evidence in the record to establish that known

mining methods, known text identification, and known data structures yielded anything other than predictable results. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. at 1739.

Additional Specific Arguments

Appellants make multiple repeated arguments (Br. 5 to 18) concerning the individual shortcomings in the teachings of each of the applied references to Hartman, Mossberg, and Boguraev. We have carefully reviewed these arguments, however, and they are not convincing of the nonobviousness of the claimed invention set forth in claim 1. For example, the Appellants criticized Hartman for not teaching that the collected profile data is from web pages and internet postings (Br. at 12, ll. 26-27). We note that Mossberg, not Hartman, is relied upon for that description as part of the combination of references. It is for this reason one can not show nonobviousness by attacking references individually when the rejection is based on a combination of references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Appellants’ arguments (Br. 14 to 18) concerning lack of a suggestion to make the combination are without merit in view of the admission by Appellants and the teachings of the applied references, especially Hartman as discussed above (Br. 14 to 17). Moreover, an express suggestion is not a rigid requirement, especially when, as here, the elements are all familiar and yield expected results.

Appellants' arguments (Br. 10 and 11) concerning lack of an enabling disclosure by Mossberg are entitled to little, if any, weight in the absence of evidence in the record to buttress such an argument. The Appellants have not shown with any persuasive evidence that one of ordinary skill in the art would not be able to data mine as described by both Mossberg and Boguraev.

Appellants' argument (Br. 16) that Boguraev is from a non-analogous art is without merit since Boguraev, like Appellants' disclosed and claimed invention, is concerned with online searching for data (col. 4, ll. 52 to 57; col. 6, ll. 66 and 67; col. 65, l. 46 to col. 66, l. 5) (FF 11). Moreover, Boguraev uses the same terminology - "mining" - in the same context. The evidence of record simply does not support the Appellants' position. Accordingly, we are unpersuaded of error in this regard.

In summary, Appellants' many arguments throughout the Brief do not convince us of any error in the Examiner's finding of obviousness of the subject matter set forth in claim 1 on appeal. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Furthermore, the Appellants have not presented any patentability arguments specifically directed to claims 2-11, 13-25, 33-44, 46-58 and 66 in the obviousness rejection based upon the combined teachings of Hartman, Mossberg, and Boguraev. As a consequence, we shall affirm the rejection of these claims.

II. The Rejection of Claims 12 and 45 over the combination of Hartman, Mossberg, and Boguraev.³

The Appellants have provided no separate argument pointing to any error in the rejection of claims 12 and 45. Accordingly, we affirm the rejection of these claims. Again we note that arguments not made in the Brief are waived. *See Hyatt v. Dudas*, 551 F.3d at 1313-14.

III. The Rejection of Claims 26 to 32 and 59 to 65 over the combination of Hartman, Mossberg, and Peach

Claims 26-32 and 59-65 stand rejected under 35 U.S.C. §103 over the combination of Hartman, Mossberg, and Peach.

The Examiner found that Peach describes selecting one or more items from a collection of computer stored images, computer stored text objects, computer stored audio objects, or other computer stored objects, and combining those objects into a deliverable medium. (Ans. at 10, Final Rejection at 7).

The Examiner then concluded that it would have been obvious to one of ordinary skill in the art to include selecting one or more items from a collection of computer stored images, computer stored text objects, computer stored audio objects, or other computer stored objects, and combining those objects into a deliverable medium and combining them into the system of Mossberg, Hartman, and Peach. (Id.).

³ Office Action, December 30, 2003, p. 6. The examiner's answer of July 21, 2004 combines this rejection with the rejection of claims 1-11, 13-25, 33-44, 46-58 and 66 at p. 2.

The Appellants urge that Peach lacks any suggestion to make the combination. (Br. at 18).

This argument has not persuaded us of error in the Examiner's rejection as it relies upon a strict application of the teaching, suggestion, motivation (TSM) test. The Supreme Court has discouraged rigid use of the TSM test, and has said that obviousness rejections must be based on an articulated reasoning with rational underpinning. Appellants have not persuaded us that the Examiner's rejection is not based upon a rational underpinning.

Thus, Appellants' arguments have not persuaded us that the Examiner's rejection of claims 26 to 32 and 59 to 65 based on the combined teachings of Hartman, Mossberg, and Peach is in error.

Accordingly, we affirm this rejection as well.

CONCLUSION OF LAW

Appellants have not shown error with the Examiner's conclusion that claims 1 to 11, 13-25, 33 to 44, 46-58, and 66 would have been obvious to one of ordinary skill in the art.

Appellants have not shown error with the Examiner's conclusion that claims 12 and 45 would have been obvious to one of ordinary skill in the art.

Appellants have not shown error in the Examiner's reasoning for finding that claims 26 to 32 and 59 to 65 would have been obvious to the skilled artisan based upon the teachings of the applied references.

ORDER

The obviousness rejections of claims 1 to 66 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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